

REMARKS

The Office action has required restriction under 35 U.S.C. § 121 between 3 groups of claims. Applicants respectfully traverse the rejection, but elect Group I with traverse in order to comply with 37 CFR § 1.143. The Applicants request reconsideration of the restriction requirement, as it was improper.

Without comment to the possible existence of multiple independent and/or distinct inventions, Applicants note that MPEP § 803 states that even if two or more claim groupings are independent or distinct as claimed, there must also be a serious burden on the examiner to require restriction. If the search and examination of the entire application can be made without serious burden, the examiner must examine the entire application. *See* MPEP §803. To make a showing of a serious burden, “the examiner must show *by appropriate explanation* one of the following:

- (A) separate classification thereof . . .
- (B) a separate status in the art when they are classifiable together[; or] . . .
- (C) a different field of search[.] . . .

MPEP § 808.02 (emphasis added). The Office action has failed to establish this burden “by appropriate explanation.”

The Office action addresses how the Groups I, II, and III might be independent and distinct, but it never addresses why there would be a serious burden on the examiner without a restriction. The only “explanation” the examiner gives is a recitation of the MPEP after the term “because.” This is clearly not an “appropriate explanation” as required by the MPEP.

Moreover, in reviewing the Office action, Applicants note that the descriptions for Groups II and III are identical, citing the same class (424) and subclass (486). “Where,

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however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.” MPEP § 808.02. Accordingly, Applicants submit that restriction between Groups II and III should not be required.

The Office action has also required an election of a single species. It is Applicants’ understanding that this election is being made to aid in conducting a search and examination of the claimed subject matter, and is not to be construed as limiting the scope of Applicants’ claims. It is also Applicants’ understanding that if the elected subject matter is found to be allowable over the prior art, the search and examination will be expanded to cover other species, until it includes the full scope of the generic claims included in the elected group. Applicants hereby elect a polymer species as poly (lactide-co-glycolide) (PLGA) and a solvent species as benzyl alcohol. Applicants list claims 1-13, 18-20, 22-53, 57-109, and 11-122 as readable on the elected species.

If the Examiner has any questions, the Examiner is invited to call the undersigned.

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